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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91190563
Party	Defendant Ross W. Greene
Correspondence Address	Parker H. Bagley GOODWIN PROCTER LLP The New York Times Building, 620 Eighth Avenue New York, NY 10018 UNITED STATES
Submission	Motion to Suspend for Civil Action
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Date	07/13/2009
Attachments	motion.pdf (5 pages)(160659 bytes)

President) in the United States District Court for the District of Massachusetts (the “Civil Action”) On July 7, 2009, Greene amended his Complaint to add Mass General as a party, seeking, *inter alia*, to enjoin Mass General and Ablon from use of Greene’s trademarks, including the COLLABORATIVE PROBLEM SOLVING and COLLABORATIVE PROBLEM SOLVING APPROACH marks and materials associated therewith. Attached as Exhibit A is a copy of the Amended Verified Complaint.

It is standard procedure for the Board to suspend administrative proceedings such as this, pending the outcome of a civil action between the same parties involving related issues. *See* 6 J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 32:47 (citing *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (C.C.P.A. 1961); *Whopper-Burger, Inc. v. Burger King Corp.*, 171 USPQ 805, 1971 WL 16554 (TTAB 1971)). The TBMP states that: “Ordinarily, the Board will suspend proceedings in the case before it if a final determination of the other proceeding will have a bearing on the issues before the Board.” *See* TBMP § 510.02(a); *see also Toro Co. v. Hardigg Indus., Inc.*, 187 U.S.P.Q. 689 (TTAB 1975). The rationale for suspension is that a court’s determination is binding on the Board, whereas the Board’s decision is not binding on the court. *Id.* (citing cases); *see also* Trademark Trial & App. Board Prac. & Proc. § 325. The fact that a civil action is filed after the Board proceeding does not change this analysis and such proceedings may also be stayed. McCarthy § 32:47 (citing *Midland Cooperatives, Inc. v. Midland Int’l Corp.*, 421 F.2d

754, 755-56 (C.C.P.A. 1970)). It is also in the interests of judicial economy to resolve the ongoing dispute between the parties in the Civil Action rather than in multiple cancellation and opposition proceedings.

This opposition proceeding should be suspended pending the outcome of the Civil Action between the parties involving the same disputed issues. The District Court will make a determination as to whether Greene is the sole and exclusive owner of the disputed trademark. Thus, the rulings and findings in the District Court will at least inform – if not be dispositive of – the principal issue involved in this Opposition.

Suspension of this proceeding pending outcome of the Civil Action is proper because the District Court's decision in that action "will have a bearing on the issues before the Board." See TBMP § 510.02(a). Both proceedings involve overlapping factual and legal issues concerning the same mark. Where the decision by the court may be dispositive of the issues before the Board, a "motion to suspend is well taken." See *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992), *abrogation on other grounds recognized by Gaylord Enter. Co. v. Calvin Gilmore Prod., Inc.*, 59 USPQ2d 1369 (TTAB 2000); *see also Kearns-Tribune, LLC v. Salt Lake Tribune Publ'g Co., LLC*, Opp. No. 151,843, 2003 WL 221324916, at *3 (TTAB Sept. 11, 2003) (citing *General Motors* and suspending proceeding where outcome of civil action "may have a bearing on the issues before the Board"); *Society of Mexican Am. Engineers and Scientists, Inc. v. GVR Public Relations Agency, Inc.*, Opp. No. 121,723, 2002 WL 31488947, at *4 (TTAB Nov. 6, 2002) (same).

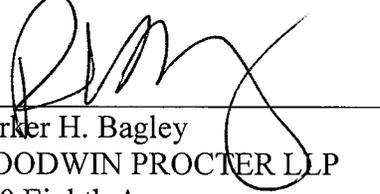
WHEREFORE, for all the foregoing reasons, Applicant Ross W. Greene.
respectfully prays that this Board reopen and suspend all proceedings herein pending the
disposition of the previously filed civil action in the United States District Court.

Dated: July 13, 2009

Respectfully submitted,

Ross W. Greene.

By his attorneys,



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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Motion to Suspend upon
Petitioner by depositing one copy thereof in a sealed envelope in the United States mail,
first-class, postage prepaid, on July 13, 2009, addressed as follows:

Andrew J. Ferren
Goulston & Storrs, P.C.
400 Atlantic Avenue
Boston, MA 02110-3333

Dated: July 13, 2009

A handwritten signature in black ink, appearing to read "Andrew J. Ferren", is written over a horizontal line.